

### REMARKS

This responds to the Office Action mailed on August 24, 2005.

Claims 16, 18-20, and 24 are amended, and claim 11 is canceled; as a result, claims 1-10 and 12-27 are now pending in this application.

#### Claim Objections

Claim 19 was objected to as containing a misspelling. Claim 19 has been amended herein.

#### Affirmation of Election

Restriction to one of the following claims was required:

Group I: Claims 1-9, drawn to a process; and

Group II: Claims 10-27, drawn to an article.

As provisionally elected by Applicant's representative, John Greaves, on August 9, 2005, Applicant elected, with traverse, to prosecute the invention of Group II, claims 10-27. The traversal is withdrawn without any admission to the merits of the Restriction Requirement.

#### §112 Rejection of the Claims

Claims 10-23 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claim 11 was canceled. Claims 15, 17, and 20 were amended. Claim 16 was also amended. Withdrawal of the rejections is respectfully requested.

#### §103 Rejection of the Claims

Claims 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelli (U.S. 5,439,707). Applicant respectfully traverses the rejection and requests the Office to consider the following.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8<sup>th</sup> Ed, Rev.1).

Claim 24 as amended includes the recitation of the brightener second film. Nelli does not teach this limitation. Because all the claim limitations are not taught in the cited reference, nor are all the claim limitations suggested by the cited reference, the amendment of claim 24 has rendered moot the rejection over Nelli. Nelli does not teach or suggest what is claimed. Withdrawal of the rejections is respectfully requested.

Claims 10-21 and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanton (U.S. 5,776,619) in view of Nelli. Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Office Action first admits that Shanton “fails to teach that the calcium carbonate in a first amount in the brightener first film, is more than the brightener particles in a second amount in the first brightener film ....” (Office Action at page 6). The Office Action also asserts that combination of Nelli with Shanton, would have been obvious to one of ordinary skill in the art. But Shanton teaches a “*preferred* base coat pigment mixture is 80 parts kaolin clay and 20 parts calcium carbonate ....” (Shanton at column 4, lines 43-45, emphasis added), *i.e.*, that the calcium carbonate in a first amount in the brightener first film is *less* than the brightener particles in a second amount in the first brightener film. Thus, Shanton teaches away from what is claimed as preferred. Nelli also teaches away from what is claimed because Nelli teaches a single coat. Thus the combination of Shanton with Nelli cannot be reached without using Applicant's disclosure as a guide. Withdrawal of the rejections is respectfully requested.

The Office Action also second admits that Shanton “fails to teach ... that a finish third film is provided above the brightener second film.” (Office Action at page 6). Applicant agrees. The Office further asserts, by contradiction of the second admission, *supra*, that “Shanton teaches that [etc.] are used as film formers ... and varnishes ....” Applicant respectfully asserts that none of these substances are taught in connection with a “finish third film” (Claim 10), rather, only in connection with Shanton's “base or top coat” (Shanton at column 5, line 28) and as otherwise described with Shanton's, *e.g.*, “preferred acrylate-styrene-acrylonitrile polymer

with a 90/10 or 80/20 blend of kaolin to calcium carbonate clearly demonstrate higher gloss varnish ....” (Shanton at column 7, lines 30-34). Thus the second admission of the Office is correct and Shanton does not teach a finish third film as claimed. The Office Action adds nothing from Nelli to remedy this deficiency. Because all the claim limitations are not taught by the cited references, alone or in combination, withdrawal of the rejections is respectfully requested.

Because claims 11-21 depend from claim 10 and because a *prima facie* case of obviousness has not been established for claim 10, withdrawal of rejection of claims 11-21 is also requested, discounting withdrawal of rejection of the canceled claim 11.

Regarding claims 12-13, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 14, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 15, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 16-17, the Office Action admits that “Shanton in view of Nelli fails to disclose that the polyvinylacetate latex and SBR latex are in a ratio of about 10:9 ....” The Office Action asserts that one can reach the limitations of claims 16-17 by use of Shanton and Nelli. But as set forth above, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claim 18, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 19-20, the Office Action admits that “Shanton in view of Nelli fails to disclose that the polyvinylacetate latex and SBR latex are in a ratio of about 1:1 ....” The Office Action asserts that one can reach the limitations of claims 19-20 by use of Shanton and Nelli.

But as set forth above, because the combination of Shanton with Nelli does not teach all the limitations of these claims as admitted by the Office with respect to claim 10, withdrawal of the rejection is respectfully requested.

Regarding claims 24-25, the Office Action uses the same mechanism to reject these claims as the rejection of claim 10. Because the Office has second admitted, however, that Shanton "fails to teach ... that a finish third film is provided above the brightener second film" (Office Action at page 6), and because as asserted above, neither does the Office invoke Nelli to remedy this deficiency, withdrawal of the rejection is respectfully requested.

Claims 22-23 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanton in view of Nelli as applied to claims 10-21 and 24-25 above, and further in view of Kinsey (U.S. 6,110,548). Applicant respectfully traverses the rejection and requests the Office to consider the following.

Kinsey adds nothing to remedy the deficiencies of Shanton in View of Nelli with respect to the limitations of the brightener first film and the finish third film of claim 10. Although Kinsey may teach a gable (claim 22), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a skived gable with an inner surface (claim 23), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a gable (claim 26), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested. Although Kinsey may teach a skived edge (claim 27), the combination of Shanton in view of Nelli and Kinsey does not teach the limitations of the brightener first film and the finish third film. Withdrawal of the rejections is respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6939 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date

Nov 28, 2005

By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 28 day of November, 2005.

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Signature

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